

## **REMARKS**

### **I. Status and Disposition of the Claims**

In the instant Application, claims 1-49 are pending. Of these pending claims, claims 1, 23, and 45 are independent.

In the Final Office Action<sup>1</sup> mailed August 4, 2009, the following actions were taken:

- Claims 1-10, 23-32, and 45-49 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lonnroth et al. (U.S. Patent No. 6,826,597 B1) (hereinafter "*Lon*") in view of Dutta et al. (U.S. Patent No. 6,615,212 B1) (hereinafter "*Dutta*");
- Claims 11-13, 15-22, 33-35, and 37-44 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Lon* and *Dutta* as applied to claims 1 and 23 in view of Bauer et al. (U.S. Patent No. 5,884,325) (hereinafter "*Bauer*"); and
- Claims 14 and 36 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Lon* and *Dutta* as applied to claims 1, 11, 12, 23, and 33 in view of Koskimies (U.S. Publication No. 2003/0233383) (hereinafter "*Koskimies*").

Applicant respectfully traverses the rejections and request reconsideration based on the following remarks.

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

## **II. Telephone Interview with Examiner**

Applicant's representatives thank Examiner Shiu and Examiner's supervisor, Ario Etienne, for the courtesies extended in granting and conducting a telephone interview on September 10, 2009, between Examiner Shiu, Examiner's supervisor Ario Etienne, the undersigned, and Ceyda A. Maisami, a student associate of the undersigned. The substance of the interview is summarized herein.

During the interview with Examiner Shiu, Applicant's representatives summarized the teachings of Applicant's application and pointed out the differences between Applicant's application and the prior art references cited by the Examiner. Moreover, Applicant's representatives provided a proposed representative claim 1 to, for example, present amendments incorporating subject matter from the dependent claims into independent claim 1.

Examiner Shiu indicated that the amendments presented by Applicant's representatives would be considered, and may require a further prior art search and consideration.

## **III. Amendments to Claims**

Applicant amends claims 1, 13, 23, and 45, and cancels claims 12, 14, 34, 36, and 49 without prejudice or disclaimer of its subject matter. Support for the amendments may be found, for example, at original claims and paragraphs [033] and [041] of the Specification. These amendments are not made to distinguish the independent claims over the prior art of record, but rather to clarify the subject matter sought to be patented.

Upon entry of this Amendment, claims 1-11, 13, 15-33, 35, and 37-48 are pending and under examination.

#### **IV. Response to Rejections**

Applicant respectfully traverses the above identified rejection of claims because a *prima facie* case of obviousness has not been established. “The key to supporting any rejection under 35 U.S.C. §103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. §2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. §2141.02(I) (emphases in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. §2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. §2141(III).

The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007) held that “[t]here is no necessary inconsistency between the idea underlying the

TSM [teaching, suggestion, motivation] test and the *Graham* analysis.” M.P.E.P. §2141(III) (rev. 6, Sept. 2007), citing *KSR* at 82 U.S.P.Q. 2d at 1396. Applicant understands this to mean that when applicable, as here, TSM reasoning may still be applied not only by an examiner but also by Applicant to refute a §103 rejection.

Here, a *prima facie* case of obviousness has not been established because the scope and content of the prior art has not been properly determined, nor have the differences between the claimed invention and the prior art been properly ascertained. Accordingly, a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art has not been clearly articulated.

The Examiner rejected claims 1-10, 23-32, and 45-49 under 35 U.S.C. §103(a) as being anticipated by *Lon* in view of *Dutta*. See Office Action at 2. Moreover, claims 11-13, 15-22, 33-35, and 37-44 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Lon* and *Dutta* as applied to claims 1 and 23 in view of *Bauer*. See Office Action at 8. At last, claims 14 and 36 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Lon* and *Dutta* as applied to claims 1, 11, 12, 23, and 33 in view of *Koskimies*. See Office Action at 11.

Applicant respectfully disagrees because the references, alone and in combination, fail to teach or suggest each and every element of the claims. However, to further prosecution and place all the claims in allowable condition, Applicant cancels claims 12, 14, 34, 36, and 49 and incorporates elements of claims 12 and 14 into claim 1, elements of claims 34 and 36 into claim 23 and elements of claim 49 into claim 45 and further amends claim 45 to recite elements similar to claim 14 or 36. Amended claim 1 reads, “automatically detecting a change in the data format requested by the

client during an exchange of data associated with the server between the server and the client,” and “modifying the data object definition within the server based on the changed data format.”

The Office Action confirms that *Lon* and *Dutta* do not disclose “wherein the changes in the data format are detected during an exchange of data between the server and the client.” Office Action at 11. *Koskimies* does not cure this deficiency, as it does not teach the above cited element.

The Office Action cites to para. [0050], lines 1-24, of *Koskimies* as teaching the above cited element. See Office Action at 11. This is incorrect. In para. [0050], *Koskimies* discloses a method of synchronizing a database with a selection data set, “The ...server synchronizes the data, i.e. analyses the changes made to the selection data set and harmonizes the data items (makes the necessary additions, replacements and deletions)... and [the server] usually waits for the client’s initiative for the synchronization.” *Koskimies* at para. [0050]. *Koskimies* suggests that the changes that can be made to the selection data set are, “Relevance values can be changed on the basis of the frequency of use, and utility values on the basis of the duration of use....” *Koskimies* at para. [0041]. Applicant respectfully points out that *Koskimies* does not detect a change in the **data format**. Moreover, *Koskimies* does not **automatically** detect changes; it instead waits for the client’s initiative. (Emphases added). Therefore, nowhere in *Koskimies* is there suggestion or teaching of “automatically detecting a change in the data format requested by the client during an exchange of data associated with the server between the server and the client,” as recited in amended

claim 1. Accordingly, *Lon*, *Dutta* and *Koskimies*, taken alone or in combination, do not teach each and every element of Applicant's claims.

Moreover, neither *Lon* nor *Dutta* nor *Koskimies* teaches or suggests, "modifying the data object definition within the server based on the changed data format."

Therefore, *Lon*, *Dutta* and *Koskimies* do not anticipate claim 1.

For at least these reasons, a prima facie case of obviousness with respect to claim 1 has not been established and, therefore, the rejection of claim 1 under 35 U.S.C. §103 as being obvious from *Lon* in view of *Dutta* is improper and should be withdrawn. For at least the reasons stated above with respect to claim 1, the rejection of claims 2-10, which depend directly or indirectly from claim 1 and therefore include all the limitations thereof, is also improper and should be withdrawn. In addition, for claims 2-10, no statement or adequate rationale as to why the references are combinable is provided.

Although of different scope, independent claims 23 and 45 recite similar features and thus also are allowable for at least the same reasons as claim 1. The rejection of claims 24-32 and 46-49, which depend directly or indirectly from claims 23 and 45, respectively, is therefore also improper and should be withdrawn.

## **V. Conclusion**

For all of the reasons cited in this response and previous responses, which are hereby incorporated by reference, Applicant submits that this claimed invention, as amended, is not obvious in view of the prior art references cited against this application.

Applicant therefore respectfully requests that this Response to Final Office Action be entered by the Examiner, placing the claims in condition for allowance. This Response to Final Office Action should allow for immediate action by the Examiner.

Further, Applicant submits that the entry of the Response to Final Office Action would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

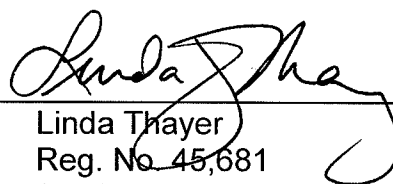
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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By: \_\_\_\_\_

  
Linda Thayer  
Reg. No. 45,681  
(617) 452-1680